

Applicant : Marco Zuniga et al.
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Attorney's Docket No.: 09464-010001

"Independent" and "distinct" are two separate non-overlapping concepts. See MPEP 802.01. Independent means there is no disclosed relationship (i.e., unrelated). See MPEP 802.01 INDEPENDENT. Distinct means that the inventions are related, but are capable of separate manufacture, use or sale as claimed. See MPEP 802.01 DISTINCT.

The Examiner has argued that the inventions are unrelated and therefore distinct. This is a contradiction. If the inventions are unrelated, they must be independent. In contrast, if the inventions are distinct, they must be related. Applicant has assumed that the Examiner intended to make the restriction on the basis of independent inventions, rather than distinct inventions.

As noted, the Examiner has imposed a restriction on the basis that the inventions are unrelated. Inventions are unrelated only if they are disclosed as not being useable together. Inventions are not usable together if they are different combinations not disclosed as capable of use together (e.g., a shoe and a locomotive bearing), if one is a process and another is an apparatus that cannot be used to practice the process, or if they are mutually exclusive species (e.g., paper clips varying in how a section of wire is formed). See MPEP 806.04(A)-(C).

The Examiner indicated in the telephone conference that that he was relying on MPEP 806.04(A), i.e., that the inventions were different combinations not disclosed as capable of use together. First, as shown by the example of a shoe and a locomotive bearing, MPEP 806.04(A) is intended for use when the inventions are in completely separate technologies. Second, the MPEP notes that "This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things." See MPEP 808.01. In other words, the MPEP itself recognizes that the situation of MPEP 806.04(A) is "rarely presented".

The Examiner noted that the inventions would require separate searches. However, the fact that inventions have different classifications is not evidence of independence. For example, a product and a process of using are often in different classifications, yet they are clearly related. See MPEP 806.05(f). Instead, separate classification is a reason to apply a restriction when the inventions are related but distinct. See MPEP 808.02.

The Examiner states "Applicant has two separate and distinct regulators. One regulator based on a first transistor and a second regulator based on two transistors." The Examiner also noted in the telephone conversation that regulators with one or two transistors are very different

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technical operation. Thus, it seems that the Examiner believes that simply because the two claimed regulators would operate differently, they must be independent. Applicant agrees that a regulator with one a single transistor would operate differently than a regulator with two transistors. However, this is not an proper basis for independence-type restriction.

The key for whether the inventions are related is whether they are disclosed as usable together. The Examiner states "It is not disclosed that these two regulators can be used TOGETHER". Unfortunately, the Examiner has misstated the requirements. The requirement is not that two different regulators be usable together, but that the claimed inventions be disclosed as usable together. This situation is analogous to the Examiner arguing that if claim 1 calls for a car with a novel brake and claim 2 calls for a car with a novel steering wheel, then claims 1 and 2 are unrelated because two cars cannot be used together. This is simply the wrong analysis - if the novel steering wheel and the novel brake can both be used in the same car, then the claimed inventions can be used together.

Since all of the limitations of both claims 1 and 11 can be found in the embodiment shown by Figure 4 (see Figure 4, page 8, lines 24-26 and page 9, lines 13-14), the inventions have been used together, and are therefore related.

In this case, the claimed inventions clearly are related as subcombinations usable together. A combination is an organization of which a subcombination or element is a part. MPEP 806.05(a). Two or more subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other. MPEP 806.05(d).

The implementation of Figure 4 is the combination: it has a first transistor [A], a second transistor [B], a filter [C], and a controller [D], with the first and second transistors having a gate oxide and being driven with different gate voltages [E], and with the first transistor having a channel length which is less than a channel length required for reliable behavior [F]. Claim 1 is the subcombination ABCDE, whereas claim 11 is the subcombination ACF. Thus, these two subcombinations are part of a single combination.

In addition, the inventions of claims 1 and 11 are separately useful, because the invention of claim 11 has utility as a single-transistor regulator but invention of claim 1 does not. Consequently, the inventions are related as subcombinations usable together, but are distinct.

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Since the inventions are distinct, and since the Examiner indicates that a separate search would be required, restriction could be appropriate under 808.02(A).

Applicant asks that the basis of the restriction be changed from unrelated to subcombinations usable together. If the Examiner agrees, then the Examiner is authorized to cancel claims 11-14.

Applicant requests that the remaining claims be allowed.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 5/19/01

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